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14          AMP Plus, Inc. doing business as  
15          ELCO Lighting and ELCO Lighting, Inc.

16          DMF, INC. a California Corporation,

17          Plaintiff,  
18          v.

19          AMP PLUS, INC. d/b/a ELCO  
20          LIGHTING, a California Corporation;  
21          ELCO LIGHTING, INC., a California  
22          corporation;

23          Defendants.

24          Case No. 2:18-cv-007090-CAS-GJS

25          **JOINT REPORT SETTING FORTH  
26          CAUSES OF ACTIONS AND  
27          DEFENSES/COUNTERCLAIMS TO  
28          BE PRESENTED AT TRIAL**

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JOINT REPORT REGARDING CAUSES OF ACTION  
AND DEFENSES/COUNTERCLAIMS TO BE  
PRESENTED AT TRIAL

Case No. 2:18-cv-007090-CAS-GJS

Pursuant to the Court's Order (Dkt 555) and direction at the February 22, 2021 oral argument on Plaintiff DMF, Inc.'s ("DMF") Motion to Enforce IPR Estoppel, DMF and Defendants AMP Plus, Inc. dba ELCO Lighting and ELCO Lighting, Inc. ("ELCO") submit the following concerning issues remaining for trial.

The parties have tentatively agreed to dismiss DMF's federal and state trademark and unfair competition claims without prejudice. Upon dismissal, ELCO's unclean hands and non-infringement defenses to those claims will be moot. The parties intend to submit a stipulation and proposed order shortly, which will leave for trial only DMF's patent infringement cause of action and ELCO's defenses and counterclaims thereto as identified by the parties below.

### **DMF's Statement**

The following is a list of the causes of action DMF intends to assert at trial:

1. Infringement of U.S. Patent No. 9,964,266 ("the '266 Patent") by ELCO's Version 1, Version 2 and Version 3 ELL products of the following asserted patent claims:

- Independent Claim 1 and its dependent Claims 2, 4-8 and 13-16
- Independent Claim 17 and its dependent Claims 19 and 21
- Independent Claim 22 and its dependent Claim 25
- Independent Claim 26 and its dependent Claims 28-30
  - a. Direct infringement under 35 U.S.C. § 271(a)
    - DMF established on summary judgment direct infringement of Claims 17, 19, 21, 22, 26 and 28-30, so the trial will not include the issue of whether those claims are infringed. *See* SJ Ruling (Dkt 499)
    - DMF established on summary judgment that all limitations of Claim 1 and its dependent Claims 2, 4-8 and 13-16 were met except certain *coupled to* limitations in Claim 1, so only

1                   those *coupled to* limitations remain for trial. *See* Rule 56(g)  
 2                   Order (Dkt 536).

3                   - Infringement of Claim 25 remains for trial.<sup>1</sup>

- 4                   b. Induced and contributory infringement under 35 U.S.C. § 271(b)  
 5                   and (c), respectively.
- 6                   c. Damages under 35 U.S.C. § 284
- 7                   d. Willful infringement and enhanced damages under 35 U.S.C. §  
 8                   284
- 9                   e. Permanent injunction (a preliminary injunction remains in  
 10                  effect)

11                  2. Trademark infringement of DMF's registered One Marks ("ONELED"  
 12                  and "ONEFRAME") and unfair competition under 15 U.S.C. §§ 1114 and 1125(a).

13                  3. Trademark infringement of DMF's One Marks under California  
 14                  common law.

15                  4. Violation of California Business & Professions Code § 17200 and  
 16                  common law unfair competition.

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12                  22         <sup>1</sup> Through an oversight in the summary judgment papers, DMF did not identify  
 13                  Claim 25 in the notice of motion even though Claim 25 was addressed by the  
 14                  parties in DMF's statement of undisputed facts and ELCO's responsive statement  
 15                  of disputed facts (SDF Dkt 366-2 at 46). ELCO's summary judgment SDF ¶¶76-78  
 16                  (Dkt 366-2 at 46) did not dispute that Claim 25 limitations were met, except  
 17                  whether the accused Version 3 products met the limitation "the sidewall has a first  
 18                  dimension between the closed rear face and the open front face of less than 2  
 19                  inches" for the same reason ELCO disputed that limitation in Claim 1, i.e., arguing  
 20                  there was an intervening "angled wall." The Court's summary judgment Order (Dkt  
 21                  499 at 11-13) resolved that dispute in DMF's favor and held that this limitation was  
 22                  met in Claim 1. DMF may seek guidance from the Court regarding how to address  
 23                  this issue.

1           **ELCO's Statement**

2           The following is a list of the affirmative defenses and counterclaims that  
 3 ELCO intends to present at trial:

- 4           a.       Non-infringement of claims 1, 2, 4-8, 13-16, and 25 of the '266 Patent  
                  (Defense and Counterclaim);
- 5           b.       Invalidity Ground 1 of Claim 17 of the '266 Patent (35 U.S.C. § 102)<sup>2</sup>  
                  (Defense and Counterclaim);
- 6           c.       Invalidity Grounds 3, 6, and 10 of all asserted claims of the '266  
                  Patent (35 U.S.C. § 103) (Defenses and Counterclaims);
- 7           d.       Failure to mark defense (35 U.S.C. § 287(b)(2));
- 8           e.       Unclean hands defense as to the ONEFRAME and ONELED federal  
                  and state trademark infringement and unfair competition claims;
- 9           f.       Non-infringement of the ONEFRAME and ONELED trademarks and  
                  Unfair Competition (15 U.S.C. § 1114 and 1125(a)) (Defenses and  
                  Counterclaims);
- 10          g.       Non-infringement of the ONEFRAME and ONELED trademarks  
                  under California Common Law (Defenses and Counterclaims);

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27          <sup>2</sup> To the extent that the Court does not apply the PTAB finding of invalidity of Claim 17

1 h. No willful infringement to support enhanced damages (35 U.S.C. §  
2 284).

3 DATED: May 19, 2021

4 BUCHALTER  
5 A Professional Corporation

6 By: /s/ Roger L. Scott

7 BUCHALTER  
8 A Professional Corporation  
9 J. Rick Taché  
Kari L. Barnes  
Roger L. Scott

10 Attorneys for Defendants  
11 AMP Plus, Inc. doing business as ELCO  
12 Lighting and ELCO Lighting, Inc.

13 DATED: May 19, 2021

14 DAVIDSON LAW GROUP

15 By: /s/ Ben M. Davidson  
16 Ben M. Davidson

17 Attorneys for Plaintiff  
18 DMF, Inc.

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and correct copy of the above and foregoing document has been served on May 19, 2021, to all counsel of record who are deemed to have consented to electronic service via the Court's CM/ECF system per Civil Local Rule 5-3.2.1. Any counsel of record who have not consented to electronic service through the Court's CM/ECF system will be served by electronic mail, first class mail, facsimile and/or overnight delivery.

/s/ Roger L. Scott  
Roger L. Scott